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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/780,378	02/17/2004	Jeff Blaylock	ZIM0356	1826
7590	02/02/2009		EXAMINER	
John F. Hoffman, Esq. BAKER & DANIELS LLP Suite 800 111 East Wayne Street Fort Wayne, IN 46802			PREBILIC, PAUL B	
			ART UNIT	PAPER NUMBER
			3774	
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			02/02/2009	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/780,378	BLAYLOCK ET AL.	
	Examiner	Art Unit	
	Paul B. Prebilic	3774	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 12 November 2008.
 2a) This action is FINAL. 2b) This action is non-final.
 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 56-75 is/are pending in the application.
 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
 5) Claim(s) _____ is/are allowed.
 6) Claim(s) 56-75 is/are rejected.
 7) Claim(s) _____ is/are objected to.
 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ . |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____. | 6) <input type="checkbox"/> Other: _____ . |

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on November 12, 2008 has been entered.

Support for the new language of the claims was not pointed out even though the Examiner requested the same in the most recent Office action; see the "Conclusions" section thereof. The Examiner will treat any future response as non-responsive if this request is not addressed.

With regard to the new language of the claims, general support was found on page 11, lines 6-14. However, the claimed ranges do not have literal support because the claimed ranges are truncated at 30 mm, 40, mm, 40 mm, and 80 mm, respectively instead of "about" the same as in the original disclosure. However, MPEP section 2163.05 III appears to give the Applicant this latitude; see the first paragraph of this section.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

- (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 56, 58-69, and 71-75 are rejected under 35 U.S.C. 103(a) as being unpatentable over Martinez et al (US 4,994,757) in view of Williams (US 5,824,103).

Martinez meets the claim language where:

- the tibial augment system as claimed is met by the joint (7) of Martinez (see the abstract, Figure 1 and column 2, lines 18-65);
- the articular component as claimed is the tibial insert (11);
- the tibial plate as claimed is the base plate (15);
- the tibial post as claimed is the stem (23) and/or bolt (17) and/or stem (41) and
- the tibial augment as claimed is the plate (13).

However, Martinez fails to disclose the size range of the tibial augment (plate (13)) as now claimed. However, Williams teaches that it was known to make similar tibial implants to fit the particular patient in need, in particular, a preferred embodiment falls within the claimed ranges; see column 6, lines 45-49 where 1.44 inches equals 37 mm ($1.44 \text{ inches} \times 25.4 \text{ mm/inch} = 37 \text{ mm}$) and 2.44 inches equals 62 mm ($2.44 \text{ inches} \times 25.4 \text{ mm/inch} = 62 \text{ mm}$). Therefore, it is the Examiner's position that it would have been *prima facie* obvious to an ordinary artisan to make the plate (13) of Martinez within the claimed size range so that it could fit a large segment of the adult human population.

Regarding claims 58 and 59, the medial and lateral widths can be taken at any point so the thickness through the edge of the plate is less than at the central part of the plate to the edge inner boundary.

Regarding claim 60, the proximal end and distal end can be the left side to the right side in Figure 1.

Regarding claim 67, the Applicant is directed to column 1, lines 44-46 and the abstract.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 70 is rejected under 35 U.S.C. 103(a) as being unpatentable over Martinez and Williams as applied to claims 56, 58-69, and 71-75 above, and further in view of Pappas (US 4,994,757). Martinez fails to teach the augment taper as claimed. However, Pappas teaches that it was known to taper the edges of similar plates; see Figure 8 and column 4, lines 35-55. Therefore, it is the Examiner's position that it would have been obvious to taper the edge of the Martinez plate (13) for the same reasons that Pappas does the same.

Claim 57 is rejected under 35 U.S.C. 103(a) as being unpatentable over Martinez and Williams as applied to claims 56, 58-69, and 71-75 above, and further in view of Johnson et al (US 6,136,029). Martinez fails to disclose the utilization of porous tantalum as the implant material. However, Johnson teaches that it was known to use porous tantalum in the art; see column 4, lines 42-58. Therefore, it is the Examiner's

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position that it would have been obvious to utilize porous tantalum as the implant material in Martinez for the same reasons that Johnson utilizes the same.

Response to Arguments

Applicant's arguments with respect to the claims have been considered but are moot in view of the new ground(s) of rejection. The new dimensions claimed have been addressed by new rejections utilizing Williams that teaches that such dimensions were known to the art.

Conclusion

Applicant should specifically point out the support for any amendments made to the disclosure, including the claims (MPEP 714.02 and 2163.06). Due to the procedure outlined in MPEP 2163.06 for interpreting claims, it is noted that other art may be applicable under 35 USC 102 or 35 USC 103(a) once the aforementioned issue(s) is/are addressed.

Applicant is respectfully requested to provide a list of all copending applications that set forth similar subject matter to the present claims. A copy of such copending claims is respectfully requested in response to this Office action if the application is not stored in image format (i.e. the IFW system) or published.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Examiner Paul B. Prebilic whose telephone number is (571) 272-4758. He can normally be reached on 6:30-5:00 M-Th.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Isabella can be reached on 571-272-4749. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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/Paul Prebilic/
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Primary Examiner
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